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09/634,356	08/09/2000	Terrence Eugene Sterkel		5710

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PRIEST & GOLDSTEIN PLLC  
5015 SOUTHPARK DRIVE  
SUITE 230  
DURHAM, NC 27713-7736

EXAMINER
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MOORE, JAMES K

ART UNIT	PAPER NUMBER
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2686

DATE MAILED: 09/25/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/634,356

Applicant(s)

STERKEL, TERRENCE EUGENE

Examiner

James K Moore

Art Unit

2686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 and 24 is/are rejected.
- 7) ☒ Claim(s) 23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Response to Arguments***

1. The finality of the rejection of the last Office action is withdrawn.
2. The indicated allowability of claims 1-18, 20-22, and 24 is withdrawn in view of various combinations of Fuji et al. (UK Patent Application No. GB 2 251 357 A), well known prior art, Dornier et al. (U.S. Patent No. 5,579,489), and Minborg (U.S. Patent Application Publication No. US 2002/0021696). Rejections based on the cited reference(s) follow.

### ***Specification***

3. The disclosure is objected to because of the following informalities:

On page 5, in line 13, "112" should be changed to "114", and "114 should be changed to "112".

On page 13, in line 7, "427" should be changed to "440".

Appropriate correction is required.

### ***Claim Objections***

4. Claim 22 is objected to because of the following informalities: in line 4, "function" should be deleted. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

Art Unit: 2686

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 6 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 6 includes the limitation "wherein the interface module comprises a universal serial bus connection." Claim 6 depends on claim 5, which includes the limitation "wherein the connectors are zero insertion force connectors". The specification does not provide enablement for a connector which is both a universal serial bus connector and a zero insertion force connector – it may be only one or the other.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 7, 18, and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 recites the limitation "the connection module" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claims 18 and 19 recite the limitation "the processing" in line 7. There is insufficient antecedent basis for this limitation in the claims.

Claim 19 also recites the limitation "the connection of the enhanced services module" in line 7. There is insufficient antecedent basis for this limitation in the claim. The examiner suggests inserting "new" before "enhanced services module".

***Claim Rejections - 35 USC § 102***

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claims 1-4, 17, and 20-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Fuji et al.

Regarding claim 1, Fuji discloses a wireless telephone comprising a basic telephone module (radiotelephone terminal unit 31) for establishing a connection to a base station (100) and processing voice and data for communication with the base station. The basic telephone module performs a group of time critical functions (e.g., transmitting and receiving voice communications) for communication with the base station and a group of non time critical functions (e.g., inputting and recalling subscriber information). See page 8, lines 15 through page 9, line 18. The telephone also comprises an enhanced services module (external device 43) that connects with the

basic telephone module in order to perform the group of non time critical functions. See page 23, line 15 through page 24, line 8. For the enhanced services module to perform the group of non time critical functions, information must transfer between the basic telephone module and the enhanced services module. It is inherent that the basic telephone module must detect the existence of the enhanced services module before it can transfer information to it. The enhanced services module receives data (selecting information) from the basic telephone module, processes the data, and passes processed data (subscriber information) to the basic telephone module during intervals when the basic telephone module has sufficient idle processing capacity available to receive the data.

Regarding claim 2, Fuji discloses all of the limitations of claim 1, and also discloses that the telephone comprises an interface module (52) for transferring data between the basic telephone module and the enhanced services module. See Figure 4.

Regarding claim 3, Fuji discloses all of the limitations of claim 2, and also discloses that the enhanced services module comprises a processor (control section 70) and a memory (storage unit (46), and it is inherent that the enhanced services module comprises a bus for transferring data between the processor and the memory and for transferring data to and from the basic telephone module through the interface module. See Figure 16.

Regarding claim 4, Fuji discloses all of the limitations of claim 3, and also discloses that the basic telephone module, the enhanced services module and the interface module each include connectors (40, 48) to allow easy connection and

disconnection of the basic telephone module to and from the enhanced services module. See Figure 4 and page 10, lines 22-27.

Regarding claim 17, Fuji discloses a method of wireless communication comprising connecting a basic telephone module (radiotelephone terminal unit 31) to an enhanced services module (external device 43), receiving inputs (selecting information) from a user and transferring data (the selecting information) between the basic telephone module and the enhanced services module, storing inputs (subscriber information) in order to perform functions selected by the user in the absence of a communication connection with a base station (100), transferring subscriber information from the enhanced services module to the basic telephone module, establishing a connection with a base station, conducting communication functions with the base station using the basic telephone module to perform time critical functions (transmitting and receiving voice communications) and the enhanced services module to perform non time critical functions (reading and writing subscriber information), and transferring data (selecting information) between the basic telephone module and the enhanced services module as needed to perform desired functions. See Figure 1 and page 23, line 15 through page 24, line 8.

Regarding claim 20, Fuji discloses all of the limitations of claim 1, and also discloses that the enhanced services module may comprise a keyboard (44). See Figure 2.

Regarding claim 21, Fuji discloses all of the limitations of claim 1, and also discloses that the enhanced services module may comprise a display (45). See Figure 2.

Regarding claim 22, Fuji discloses a wireless telephone comprising an interface module (interface connector 51), an enhanced services module (external device 43) removably attached to the interface module, and a basic telephone module (radiotelephone terminal unit 31) removably attached to the interface module. See Figure 4 and page 10, lines 22-27. The basic telephone module controls scheduling of data transfer between the basic telephone module and the enhanced services module by indicating (by transferring code-converted information to the enhanced services module) when the basic telephone module is ready to receive data (subscriber information). See Figure 9 and page 18, lines 3-17.

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fuji et al. in view of well known prior art.



Regarding claim 5, Fuji discloses all of the limitations of claim 4, but does not disclose that the connectors are zero insertion force connectors. However, it is well known in the art that zero insertion force connectors provide easy connection and disconnection. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Fuji, such that the connectors are zero insertion force connectors, in order to easily connect and disconnect the basic telephone module and enhanced services module.

13. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fuji et al. in view of well known prior art as applied to claim 5 above, and further in view of Dornier et al.

Regarding claim 8, Fuji in view of well known prior art teaches all of the limitations of claim 5, but does not teach that the enhanced services module (electronic notebook) includes external device interfaces for connecting the telephone to external devices, or that the bus also transfers data between the processor and the external device interfaces.

Dornier discloses an electronic notebook which includes a processor (11), a bus (40), and an external device interface (20) for connecting to external devices (such as a printer, a FAX modem, or a scanner). The bus transfers data between the processor and the external device interfaces. The external device interface provides enhanced functionality to the electronic notebook. See Figure 3; col. 6, lines 30-42; and col. 7, lines 11-30. It would have been obvious to one of ordinary skill in the art at the time of

Art Unit: 2686

the invention to further modify the combination of Fuji and well known prior art with Dornier, such that the enhanced services module includes external device interfaces for connecting the telephone to external devices and the bus also transfers data between the processor and the external device interfaces, in order to enhance the functionality of the telephone.

14. Claims 9-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fuji et al. in view of well known prior art and Dornier et al. as applied to claim 8 above, and further in view of Minborg.

Regarding claim 9, Fuji in view of well known prior art and Dornier teaches all of the limitations of claim 8, but does not teach that the external device interfaces include a subscriber identity module interface.

However, Minborg discloses an electronic notebook having a subscriber identity module (SIM) interface that interfaces with a SIM card (1654). The SIM card allows the electronic notebook to retain stored information should power be temporarily unavailable. See paragraph 298 on page 12. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the combination of Fuji, well known prior art, and Dornier with Minborg, such that the external device interfaces include a subscriber identity module interface, in order to allow the telephone to retain stored information should power be temporarily unavailable.

Regarding claim 10, Fuji in view of well known prior art, Dornier, and Minberg teaches all of the limitations of claim 9. Additionally, a Y-cable interface, an infrared device adapter interface, and a Bluetooth interface are all commonly used interfaces for connecting peripheral devices with electronic devices. It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the combination of Fuji, well known prior art, Dornier, and Minberg, such that the external device interfaces include a Y-cable interface, an infrared device adapter interface, and a Bluetooth interface, in order to connect the enhanced service module with external devices via interfaces that are in common use.

Regarding claim 11, Fuji in view of well known prior art, Dornier, and Minberg teaches all of the limitations of claim 10. Minberg also discloses an electronic notebook (1691) which performs a worldwide web browser function to allow user communication over an Internet connection. See paragraphs 6-10 and 298. It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the combination of Fuji, well known prior art, Dornier, and Minberg with this teaching of Minberg, such that the enhanced services module performs a worldwide web browser function to allow user communication over an Internet connection, in order to enhance the functionality of the enhanced services module.

Regarding claim 12, Fuji in view of well known prior art, Dornier, and Minberg teaches all of the limitations of claim 11. Fuji also discloses that the basic telephone module includes user interface components (keypad 35) and that the enhanced services module provides enhancements to the user interface components of the basic

telephone module by receiving basic data signals (selecting information) from the user interface components, retrieving enhanced data signals (subscriber information) in response to the basic data signals, and supplying the enhanced data signals to the basic telephone module. See Figure 10 and page 18, line 25 through page 19, line 23.

Regarding claim 13, Fuji in view of well known prior art, Dornier, and Minberg teaches all of the limitations of claim 12. Fuji also discloses that the user interface components of the basic telephone module includes a keypad (35), and that the enhanced services module receives keystroke information from the basic telephone module, retrieves enhanced keystroke data in response to the keystroke information, and supplies the enhanced keystroke data to the basic telephone module. See Figure 10 and page 18, line 25 through page 19, line 23.

Regarding claim 14, Fuji in view of well known prior art, Dornier, and Minberg teaches all of the limitations of claim 13. Fuji also discloses that the user interface components of the basic telephone module include a display (38), and that the enhanced services module receives display data (selecting information) from the basic telephone module, adds display enhancements (subscriber information) to the display data and transfers the display data and displays enhancements to the basic telephone module for display. See Figure 10 and page 18, line 25 through page 19, line 23.

Regarding claim 15, Fuji in view of well known prior art, Dornier, and Minberg teaches all of the limitations of claim 14. Fuji also discloses that the enhanced services module produces enhanced services module display data (subscriber information) and transfers the enhanced services module display data to the basic telephone module in

order to display the enhanced services module display data. See Figure 10 and page 18, line 25 through page 19, line 23.

Regarding claim 16, Fuji in view of well known prior art, Dornier, and Minberg teaches all of the limitations of claim 15. Fuji also discloses that the enhanced services module display data includes personal organizer information retrieved from the enhanced services module and processed for display. See page 8, line 26 through page 9, line 3.

15. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fuji et al. in view of Dornier et al.

Regarding claim 24, Fuji discloses a wireless telephone comprising a basic telephone module (radiotelephone terminal unit 31) for establishing a connection to a base station (100) and processing voice and data for communication with the base station. See page 8, lines 15-25. The basic telephone module has a first processor (control section 60) and basic components (keypad 35, radio transmitting unit 39) needed for operation. See Figure 2 and page 11, lines 2-7. It is inherent that the basic telephone module comprises an internal bus to communicate between the processor and the basic components. The basic telephone module performs time critical functions (transmitting and receiving voice data) for communication with the base station. The wireless telephone also comprises an enhanced services module (external device 43, which may be an electronic notebook) that connects with the basic telephone module in order to perform non time critical functions (writing subscriber information to storage unit

46). See page 23, line 15 through page 24, line 8. The enhanced services module has a second processor (control section 70) and inherently has an internal bus to communicate between the processor and other components of the enhanced services module. The enhanced services module receives data (subscriber information) from the basic telephone module and passes processed data (subscriber information) to the basic telephone module during intervals when the basic telephone data has sufficient idle processing capacity available to receive the data. Fuji does not disclose that the enhanced services module has an optional hardware component, or that data is processed by communicating between the second processor and the optional hardware component.

However, Dornier discloses an electronic notebook comprising a processor (11) and an optional hardware component (e.g., a printer). Data is processed by communicating (via internal bus 40) between the processor and the optional hardware component. The optional hardware enhances the functionality of the electronic notebook. See Figure 3; col. 6, lines 30-42; and col. 7, lines 11-20. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Fuji with Dornier, such that the enhanced services module has an optional hardware component, such as a printer, and that data is processed by communicating between the second processor and the optional hardware component, in order to enhance the functionality of the enhanced services module.

***Allowable Subject Matter***

16. Claims 18 and 19 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

17. Claim 23 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

18. The following is a statement of reasons for the indication of allowable subject matter:

The present invention is directed to a method of upgrading a wireless telephone. The method comprises removing an enhanced services module from a basic telephone module. The method also comprises connecting the enhanced services module to a new basic telephone module, or alternatively, connecting the basic telephone module to a new enhanced services module. The basic telephone module and enhanced services module perform a group of non time critical functions.

Claims 18 and 19 identifies the uniquely distinct feature "transferring the processing of the group on non time critical functions to the enhanced services module."

The closest prior art, Fuji et al., discloses a method of upgrading a wireless telephone which comprises removing an enhanced services module from a basic telephone module, and which may also comprise connecting the basic telephone module and enhanced services module to new basic telephone modules and enhanced services modules. The basic telephone module and enhanced services module perform

Art Unit: 2686

a group of non time critical functions. However, Fuji fails to anticipate or render the above underlined limitations obvious.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ken Moore, whose telephone number is (703) 308-6042. The examiner can normally be reached on Monday-Friday from 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold, can be reached at (703) 305-4379.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 872-9314 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

Ken Moore

9/17/03

*JKM*

*Marsha D Banks-Harold*  
**MARSHA D. BANKS-HAROLD**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2600**